

composition or structure of the base hydrolyzing means. By analogy, it is like further defining pivoting means as having a region of aluminum. Surely, no method is recited. It is also noted that no verb or verb transitive other than "comprises" is recited in claim 7. How can a method step exist without a verb? It is clear that no method step is claimed in claim 7 and the rejection should be withdrawn.

Claim 9 also contains no method steps; the closest thing to verbs in claim 9 are the verb transitives "includes" and "comprises". Furthermore, the recited "predetermined component includes acetaldehyde" is a compositional or structural limitation and is not a method step. Likewise, the recited "purified permeate comprises the distillation residue from the distillation column" is a compositional or structural limitation and not a method step. The rejection should be withdrawn.

Claim 10 also contains no method steps; the only verb transitives are "includes" and "comprises". Furthermore, the recited "predetermined component includes an alcohol" is a compositional or structural limitation and is not a method step. Likewise, the recited "purified permeate comprises the distillation residue from the distillation column" is a compositional or structural limitation and not a method step. The rejection should be withdrawn.

Claim 11 also contains no method steps; the only verb transitives are "includes" and "comprises". Furthermore, the recited "predetermined component includes an alcohol" is a compositional or structural limitation and is not a method step. Likewise, the recited "purified permeate comprises the distillate from the distillation column" is a compositional or structural limitation and not a method step. The rejection should be withdrawn.

If the Examiner still believes that the limitations recited in claims 7 and 9-11 are method limitations, it is respectfully requested that the rejection be clarified by indicating precisely where method steps are recited in each of claims 7 and 9-11.

The specification has been objected to under 35 U.S.C. Section 112, first paragraph, as failing to provide support for the limitation "a distillation column for producing a first portion higher in alcohol and a second portion lower in alcohol" and the limitation "combining the retentate with one of said first and second portions for producing a treated solution" recited in



claim 21. In response to the invitation to point out the specification basis for these limitations, the Examiner's attention is respectfully directed to page 16, lines 3 through 14, of the specification. As discussed below, there is no requirement that the exact words of the claim appear precisely in the specification if the claim elements are otherwise disclosed.

The specification specifically indicates, at page 16, lines 3-9, that "the treatment column... may alternatively be a... distillation column, so that the apparatus may be used to either increase or decrease the amount of alcohols.... [T]he distillation residue (lower in alcohol)... is recombined with the retentate." It is also specifically indicated, at lines 12-14, that "...the distillate (higher in alcohol) is taken... and is recombined with the retentate." Even though the wording of the claim is slightly different it is clear that the distillate corresponds to the recited first portion and the distillation residue corresponds to the recited second portion. It is thus shown that there is in fact support in the specification for the recited elements.

It is well-settled that the subject matter of a claim need not be described literally or "in haec verba" in order for the specification to satisfy the description requirement of Section 112. See In re Lukach, 442 F.2d 967, 969, 169 USPQ 795 (CCPA 1971). The Board of Appeals has stated that:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

Ex parte Harvey, 3 USPQ2d 1626, 1627 (PTO Bd. Pat. App. & Int. 1987). Since the specification clearly supports claim 21, the objection to the specification should be withdrawn. For the above reasons, it is respectfully submitted that the rejection of claims 21-23 under 35 U.S.C. Section 112, first paragraph, should also be withdrawn.

Claims 1,3,4 and 8-11 have been rejected under 35 U.S.C. Section 102(b) as anticipated by U.S. Patent No. 4,792,402 to Fricker (hereinafter "Fricker"). As amended, claims 1,3,4 and 8-11 include, inter alia, a heat exchanger for controlling the retentate temperature. Support for the amendment is provided in the specification at page 7, lines 13-21, where it is also indicated

that the retentate may be adversely affected when it is heated by the pumping process. There is no teaching or suggestion in Fricker, either taken alone or in combination with any of the cited references, of such an element. Since each element of a claim must be present in the cited reference for anticipation to occur, the present rejection should be withdrawn.

The addition of the "heat exchanger" component to claim 1 is a key point of distinction between the Fricker reference and the present invention. Fricker's system is primarily described with reference to "concentrating" beer while the present invention is directed to affecting the flavor in wine. In beer processing, the beer is often heated to temperatures of 70° C or greater. Wine could never be heated to those temperatures without destroying the flavor completely. Therefore, the heat exchanger maintains the wine temperature at levels which do not damage the wine.

Claims 2 and 5-7 have been rejected under 35 U.S.C. Section 103 as being unpatentable over Fricker in view of U.S. Patent No. 4,205,092 to Mattick et al. (hereinafter "Mattick"). Since claims 2 and 5-7 depend from claim 1, they incorporate the limitations of the base claim. As above, there is no teaching or suggestion, in Fricker or Mattick, either taken individually or together, of a heat exchanger for controlling the retentate temperature. Moreover, since Fricker is unrelated to reducing acidity and Mattick has nothing to do with concentrating alcoholic beverages, there is no motivation to combine Fricker and Mattick. Further, Mattick teaches against the use of ion exchange to process wine because of its negative impact on flavor characteristics.

As was stated in In re Fritch, 23 USPQ2d 1780, 1783-1784 (Fed. Cir. 1992):

The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. ...It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious... [O]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures of the prior art to deprecate the claimed invention.

Prima facie obviousness can only be established by showing some objective teaching that would lead one with skill in the art to combine the relevant references. In re Fritch, supra at 1783. There is no such objective teaching in the present case. In fact, the references teach away from the combination. Consequently, the rejection of claims 2 and 5-7 under Section 103 should be withdrawn.

A significant distinction between Fricker and the present invention, which is borne out in these apparatus claims, is that Fricker is concentrating the beer by removing water, and then reconstituting it by adding water back in at the point of consumption thus affecting savings by not having to transport water. When the beer is reconstituted, there is no affect on flavor or aroma. Thus, Fricker's processing is "consumer neutral" in that the processed-and-then-reconstituted beer has the same taste and flavor as the original beer before processing. In contrast, the present invention is not "consumer neutral" because the purpose of the apparatus is to be able to modify acidity levels to enhance the flavor and aroma to make it more appealing to consumers. In essence, the present invention is additive or subtractive to the wine, rather than concentrative as is Fricker's process. Fricker therefore teaches away from the present invention in this regard, and should not be available to reject the claims.

Claims 21-23 have been rejected under 35 U.S.C. Section 103 as being unpatentable over Fricker. The rejection is respectfully traversed. The Examiner contends that it would have been "obvious to employ the distillation column of Fricker to produce a first permeate portion higher in alcohol and a second portion lower in alcohol followed by combining the retentate with one of the first and second permeate portions for producing a low alcohol wine or a high alcohol wine since it simply depends on consumer preference." This statement is completely unsupported by the cited references. Fricker is devoid of any suggestion to produce a first portion higher in alcohol and a second portion lower in alcohol and to combine the retentate with one of the first and second portions. The purpose of Fricker is to produce a concentrated beer, higher in alcohol, which can be diluted at the point of use, for purpose of easing transport. Fricker teaches concentration which is ultimately consumer neutral, and is very different from the present invention. Fricker teaches away from the concept of flavor change because it is his

goal to concentrate without damaging the flavor upon reconstitution. Since Fricker does not support the Examiner's position and there is no basis in any of the cited art, either taken alone or in any combination, for the Examiner's statement, the rejection of claims 21-23 under Section 103 should be withdrawn. See In re Fritch, *supra*.

A good faith effort has been made to place the present application in condition for allowance. Reconsideration of the objections and rejections is earnestly solicited. If there is any point needing clarification prior to allowance, the Examiner is respectfully requested to telephone the undersigned attorney for applicant at the below-listed address.

Respectfully submitted,
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